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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

659/2240 (K-C 14,676.18)

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on December 14, 2005

Signature

Typed or printed name Peter Brunovskis

Application Number

10/771,969

Filed

February 4, 2004

First Named Inventor

Ligia A. Rivera

Art Unit

1772

Examiner

Alexander S. Thomas

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒

attorney or agent of record.

Registration number 52,441☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

Peter Brunovskis

Typed or printed name

312-321-4200

Telephone number

December 14, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Peter Brunovskis, Reg. No. 52,441

Name of applicant, assignee or
Registered Representative

Signature

December 14, 2005

Date of Signature

Case No. 659/2240 (K-C 14,676.18)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Ligia A. Rivera et al.)

Serial No.: 10/771,969)

Filing Date: February 4, 2004)

For: ROLL OF WET WIPES)

Examiner: Alexander S. Thomas

Group Art Unit No.: 1772

REASONS SUPPORTING PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to the new pre-Appeal Brief Conference Pilot Program as described in 1296 OG 67 on July 12, 2005, Applicants respectfully submit the following arguments:

The claimed subject matter relates to a roll of wet wipes comprising a wetting composition comprising at least about 1 weight percent of inorganic salt. Pending claims 81-89, 111-114, 119 and 120 further define the roll and wet wipes according to specific dimensions. Of these, claims 81-87, 111-114, 119 and 120 stand rejected over Applicant's background statements in view of Gordon et al. (U.S. Pat. No. 5,763,332, hereinafter "Gordon"). Claims 88 and 89 are allowable, but stand objected to as

depending from a rejected claim. Pending claims 90-100, 115-118, 121 and 122 are defined by further requiring a groove. Of these, claims 90-98, 115-118, 121 and 122 stand rejected as obvious over the above prior art further in view of Nissing et al. (U.S. Pat. No. 6,623,834; hereinafter "Nissing"). Claims 99 and 100 are allowable, but stand objected to as depending from a rejected claim.

The obviousness rejections are legally flawed and factually deficient for the following reasons:

- (1) Missing claim elements;
- (2) Inappropriate reliance on Applicant's background as prior art;
- (3) Lack of motivation for applying Gordon's teachings
 - (a) Gordon's teachings are inapplicable to wet rolls;
 - (b) Gordon teaches away from the claimed invention.
 - (c) Gordon fails to suggest the benefits relied on by the Examiner

§ 103 rejection: Applicants' background statements in view of Gordon

Claims 81-87, 111-114, 119 and 120 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over applicants' acknowledged state of the art in view of Gordon. According to the Final Office Action, Applicants' background discloses the invention substantially as claimed, namely a roll of wet wipes with perforated sheets; and Gordon discloses the desirability of the use of a sodium chloride containing composition on wet wipes. The Examiner argued that it would have been obvious to use the antibacterial composition of the secondary reference to provide a wet wipe with enhanced cleaning properties. Regarding the size of the roll, the Examiner stated that it would have been obvious to adjust the size of the wet wipes to accommodate a particular end use.

Missing claim elements

The Examiner has not provided Applicants with a reference or a combination of references which teaches or suggests all the elements depending from claim 81. In particular, neither Applicants' background nor Gordon discloses or suggests a roll having at least 300 linear inches of wet wipes, the wet wipes having a width of not more than about 4.5 inches, wherein the diameter of the roll is at least about 2 inches and no

greater than about 5.5 inches. The Final Rejection states that it would have been obvious to adjust the size of the wet wipes to accommodate a particular end use of the wipe. However, the Office Action does not provide any particular end use described in a prior art reference that would necessitate or motivate a skilled artisan to modify a roll of wet wipes according to the present claims.

Inasmuch as the background teachings fail to supply the missing wet roll dimension elements, the missing claim elements appear to be derived from the Examiner's personal knowledge. However, to support such a rejection, the Examiner must set forth facts supported by an affidavit "when called for by the applicant". 37 CFR 1.104(d)(2). However, despite Applicants' challenge, no such affidavit has yet been provided.

Inappropriate reliance on Applicant's background as prior art

Further, the Examiner's assertion that Applicants' background statements qualify as prior art is contrary to law. In the decision of *In re Dow Chemical Co.*, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988), with reference to background description in a patent application, the Federal Circuit notes:

That there were other attempts, and various combinations and procedures tried in the past, **does not render obvious** the later successful one ... Further, a patent applicant's statement of the purpose of the work is **not prior art**.
[Emphasis and ellipsis added]

Lack of motivation to combine: Gordon is not applicable to wet wipes

Gordon does not disclose a roll of wet wipes. Gordon's wipes are predicated on *not* being wet unless shear is applied to rupture an emulsion contained within the wipe, thereby releasing a wetting composition encapsulated within the emulsion. In other words, Gordon's wetting composition is encapsulated in an emulsion so as to be shielded from the wipes until the point of use.

Lack of motivation to combine: Gordon teaches away from using wet wipes

Gordon teaches away from using wet wipes. Gordon's background section discusses prior art wipes kept in a dispenser soaked in a moistening solution having a

permanent wet strength such that they are not flushable and teaches that prior art wipes are often too wet to dry the skin and have a cold feel (see col. 2, lines 38-46). In contrast, the claims are directed to a roll of wet wipes fully exposed to a wetting composition and completely wet *before* use.

Lack of motivation to combine: Gordon fails to suggest benefits relied on by the Examiner

Not surprisingly, the Examiner does not suggest applying Gordon's emulsion to confer further wetness or as a substitute for an external wetting solution (which would not be a wet wipe according to the present claims). Instead, the Examiner argues that Gordon discloses the desirability of a sodium chloride containing composition on wet wipes and that it would have been obvious to use the antibacterial composition of the secondary reference on the article to provide a wet wipe with enhanced cleaning properties. However, Gordon does not disclose or suggest any antibacterial or cleaning benefit associated with the encapsulated wetting composition.

Gordon's reason for using sodium chloride is not applicable to wipes saturated with a wetting composition. Sodium chloride is used in the internal polar phase of the emulsion as an electrolyte to minimize the tendency of materials present in the lipid phase to also dissolve in the water phase (col. 14, lines 8-15). Accordingly, the skilled artisan would not find any benefit in using sodium chloride in a wetting composition unless there was a substantiated need for an emulsion, which is not the case.

In view of Gordon's failure to provide a benefit for using the disclosed wetting composition that could be reasonably applicable to wet rolls, Gordon cannot be reasonably combined except by inappropriate hindsight. In essence, to apply Gordon's wetting composition to a prior art wet roll, the skilled artisan would need to disassociate a wetting composition from an emulsion used for one benefit or purpose, and extrapolate from Gordon new benefits, *i.e.*, antibacterial and/or cleaning benefits not suggested or disclosed by Gordon, and apply the wetting composition to a wet roll. To jump through these hoops would not be obvious, however. Given the insufficient evidence and motivation to support a *prima facie* case of obviousness, the present claims cannot be obvious under 35 USC § 103 over Applicants' background and Gordon.

§ 103 rejection: Applicants' background in view of Gordon and Nissing

Claims 90-98, 115-118, 121 and 122 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over applicants' background statements in view of Gordon as applied to claims 81-87, 111-114, 119 and 120 above, and further in view of Nissing.

According to the Examiner, Applicants' acknowledged state of art discloses the invention substantially as claimed, namely a roll of wet wipes with perforated sheets; Gordon discloses the desirability of the use of a sodium chloride containing composition on wet wipes; and Nissing discloses the desirability of providing transverse grooves in wet wipe material to aid in cleaning surfaces. Because all of the rejected claims require a wetting composition as claimed, Nissing cannot cure Gordon's deficiencies, since Nissing, relied on for its groove teachings, fails to teach or suggest any wetting composition according to the present claims.

Double Patenting

Claims 81-87, 90-98 and 111-122 were rejected over claim 41 of copending Application No. 10/664,342. Provided that all of the other rejections are withdrawn, the "provisional" double patenting rejections must be withdrawn. MPEP 804 (I)(B).

Applicants submit that pending claims 81-100 and 111-122 are patentable and respectfully request that the Examiner allow the pending claims. The Panel is kindly invited to contact the undersigned Agent via telephone if such communication would expedite the prosecution of this application.

Respectfully submitted,



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